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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,362	11/15/2001	Hisashi Kugimoto	CU-2720 RJS	4660

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LADAS & PARRY
224 SOUTH MICHIGAN AVENUE, SUITE 1200
CHICAGO, IL 60604

EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-3

Office Action Summary

Application No.

10/003,362

Applicant(s)

KUGIMOTO, HISASHI

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

This Office Action is responsive to the amendment filed 6-4-03. The 112 rejection is withdrawn. The claim objection is withdrawn.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

3. Claims 1-2, 4 and 6 (new) are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,870,224 to Saitoh et al.

Saitoh teaches a lenticular sheet comprising a UV curable resin on its surface, on the side of a transparent resin film support that has the lens part on it. The resin film has a protective film on each side of the film and an adhesive agent, adhered to the film (see col. 4, lines 15-55, Figure 11, and col. 5, lines 43-64).

Regarding claim 2, the adhesive strength of 0.4 to 2.3 N/25mm is inherent since the same material is used.

Regarding claim 4, the adhesive agent contains a polyolefin-based resin component, polyethylene terephthalate at col. 4, line 53.

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Regarding claim 6, a support film (base sheet) is taught at col. 5, lines 15-20 having a UV curable resin on it and at col. 4, lines 46-54, the support is of PET or PVC. Further at col. 5, line 50, adhesive 1110 is taught as having a protective film 8 on it. Both 1110 and 8 are on the support film 1210. It is known that supports are molded as the same process in Applicant's disclosure at col. 1, line 64-col. 2, line 4.

That a transmittance of UV rays transmit through the protection film is a process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5 and 7 (new) are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,870,224 to Saitoh et al. in view of USPN 5,459,021 to Ito et al.

Saitoh teaches a lenticular sheet comprising a UV curable resin on its surface, on the side

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of a transparent resin film support that has the lens part on it. The resin film has a protective film on each side of the film and an adhesive agent, adhered to the film (see col. 4, lines 15-55, Figure 11, and col. 5, lines 43-64. Saitoh is relied upon for claim 1 as discussed above.

That a transmittance of UV rays transmit through the protection film is a process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

Regarding claim 7, Saitoh does not teach an antistatic agent with a cationic substance, nor a surface resistivity value of less than 1×10^{12} Omega/square. While Saitoh teaches his film may provide an antistatic function, Saitoh does not state *per se* that he adds an antistatic agent to produce an antistatic functional layer. However, Ito teaches a silver halide photographic light-sensitive material, which shows it is known to provide an antistatic agent such as anti-static agent with a cationic substance (e.g. sulfonium salts) which may be added in order to provide functions such as providing of lubricant property at col. 6, lines 52-60 and col. 9, lines 20-36. Ito further explains the specific surface resistance (surface resistivity) of the light-sensitive silver halide emulsion side after being subjected to photographic processing is not more than 1×10^{12} OMEGA/per square, meeting Applicant's less than 1×10^{12} Omega/square at col. 9, lines 7-24. Both Ito and Saitoh teach light-sensitive materials and are hence, analogous art. Therefore, it would have been obvious to one of ordinary skill in the art to modify the lenticular sheet of

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Saitoh to further include a cationic substance for the purpose of providing lubrication.

Additionally, it would have been obvious to include a surface resistivity value as claimed to provide electroconductivity. Further, Applicant includes the process limitations “the protection film is pasted from the side of the adhesive...” which are not dispositive of the issue of patentability of the present article claims.

The surface resistivity and its value given add no positive recitation to the claim as this appears only to occur “after one year”. These phrases add nothing to the claim. Therefore, the claim is being interpreted as a protection film.

Saitoh is silent to teaching an acrylic resin included in the base sheet. However, Ito teaches acrylic may be added as a binder in the base, magnetic layer at col. 5, line 49. Hence it would have been obvious to one of ordinary skill in the art to modify the sheet of Saitoh to include acrylic since Ito teaches it is conventional to do so at col. 5, line 49.

Response to Arguments

Applicant's arguments filed 6-4-03 have been fully considered but they are not persuasive.

Applicant contests Saitoh does not teach a protection film or functions as protection. However, Applicant appears to ignore the Saitoh citing at col. 5, lines 45 & 61 teaching a protection film. Applicant's argument is not persuasive. Applicant argues that the positive type ultraviolet-sensitive agent 1110 of Saitoh is different from the base sheet of the instant application. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., base sheet) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van*

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Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The instant claims are directed to a protection film **for** a base sheet.

Applicant further attests that the base sheet of the application has no adhesive itself. The instant claim addresses a protective film with an adhesive on it. Saitoh teaches this limitation. At col. 4, lines 15-55, Figure 11, and col. 5, lines 43-64, the resin film has a protective film on each side of the film and an adhesive agent, adhered to the film.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tamra L. Dicus
Examiner
Art Unit 1774

August 18, 2003

A handwritten signature in black ink, appearing to read "Bruce Hess". The signature is fluid and cursive, with the first name "Bruce" and the last name "Hess" clearly distinguishable.

BRUCE H. HESS
PRIMARY EXAMINER